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PATENT APPLICATION

ATTORNEY DOCKET NO. 200311912-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):	**Kevin Lo et al.**	**Confirmation No.:**	**1507**
Application No.:	**10/611,393**	**Examiner:**	**HSIEH, Shih Wen**
Filing Date:	**June 30, 2003**	**Group Art Unit:**	**2861**

Title: An Ink Over-Spray Containment Apparatus and Method

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on August 28, 2008.

☒ The fee for filing this Appeal Brief is $540.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $130	☐ 2nd Month $490	☐ 3rd Month $1110	☐ 4th Month $1730

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of $ 540. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Kevin Lo et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Kevin Lo et al.

Application No. 10/611,393

Filed: June 30, 2003

For: An Ink Over-spray Containment Apparatus and Method

Group Art Unit: 2861

Examiner: HSIEH, Shih Wen

APPEAL BRIEF

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Sir:

This is an Appeal Brief under Rule 41.37 appealing the decision of the Primary Examiner dated July 2, 2008 (the "final Office Action"). Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the Appellant is aware.

III. Status of Claims

Claims 2 and 42 have been cancelled and are *not* at issue in this appeal.

Claims 4-41 and 43 stand allowed and are *not* at issue in this appeal.

Claims 1, 3 and 44 stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 1, 3 and 44, which claims are presented in the Appendix.

IV. Status of Amendments

No amendments have been filed subsequent to the final Office Action of July 2, 2008, from which Appellant takes this appeal.

V. Summary of Claimed Subject Matter

The sole independent claim at issue in this appeal is claim 1. Claim 1 recites:

1. An ink over-spray containment apparatus, comprising:

a first member (210) having a first fluidic transport coefficient and a first ink affinity (*Appellant's specification, paragraph 0020*);

a second member (220) coupled to said first member (*Appellant's specification, paragraph 0020*), said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity (*Appellant's specification, paragraphs 0007 and 0015*);

wherein said first member comprises porous plastic (*Appellant's specification, paragraph 0038*).

VI. Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following sole ground of rejection.

(1) Claims 1, 3 and 44 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,024,548 to Alonso et al. ("Alonso").

According, Appellant hereby requests review of this rejection in the present appeal.

VII. Argument

(1) Claims 1, 3 and 44 are patentable over Alonso:

Claim 1:

Claim 1 recites:

> An ink over-spray containment apparatus, comprising:
> a first member having a first fluidic transport coefficient and a first ink affinity;
> a second member coupled to said first member, said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and *a second ink affinity greater than said first ink affinity*;
> wherein said first member comprises porous plastic.

(Emphasis added).

As explained in Appellant's specification and as recited in claim 1, the fluidic transport coefficient and ink affinity are two properties of the first and second members that can vary with some independence. Appellant's specification expressly states that "fluidic transport coefficient shall refer broadly to a material's ability to move a fluid. In addition, ink affinity shall refer broadly to a material's tendency to adsorb ink." (Appellant's specification, paragraph 0015).

Claim 1 expressly recites that while the fluidic transport coefficient of the second member is less than that of the first member, the ink affinity of the scone member is greater than that of the first member; "said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity." Thus, the two properties, the fluidic transport coefficient and ink affinity, can and do vary with some independence as recited in claim 1.

In contrast, Alonso utterly fails to address this distinction between the fluidic transport coefficient and ink affinity. Alonso, as cited in the current record, teaches "a liquid absorbing assembly with two porosities." (Alsono, title). According to Alonso,

> The ink mist absorbing assembly 13 includes a support frame 17, which is formed of a suitable plastic material such as polypropylene, for example, a first porous material 18, and a second porous material 19. The first porous material 18 has a greater porosity than the second porous material 19 since the pores in the first porous material 18 are larger than those in the second porous material 19.

(Alonso, col. 2, lines 34-41) (*see* final Office Action, p. 3).

Alonso further explains that

> The rate of transfer of the ink from the first porous material 18 to the second porous material 19 is dependent upon the viscosity of the ink, the pore size openings of the porous materials 18 and 19, and the thickness of the first porous material 18. Thus, the first porous material 18 is relatively thin to enable a rather rapid rate of transfer of the ink from the first porous material 18 to the second porous material 19.

(Alonso, col. 3, lines 33-40) (*see* final Office Action, p. 3).

Thus, Alonso addresses the rate of fluid transfer between two materials that have differently sized pores and consequently different porosities. Alonso does not, however, teach, suggest or even mention the concept of "ink affinity."

As expressly recited in claim 1, the ink affinity of the second member is higher than that of the first member, even though the second member has a lesser fluidic transport coefficient than the first member, i.e., "said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity." Alonso utterly fails to teach, suggest or even mention the relative ink affinity feature of the first and second members in claim 1.

The final Office Action attempts to address this subject matter as follows. The "Examiner contends that: the capillary forces of the pores shall correspond to the fluidic transport coefficient." (final Office Action, p. 7). Whether or not this is correct, the Action then fails, however, to understand or accurately address the *separate and independent*

property of ink affinity. In the words of the Action, "the term of 'ink affinity' is closed [sic] related to 'fluidic transport coefficient'. Or, these two things are front and back sides of one thing." (*Id.*). This is clearly incorrect.

To the contrary, as explained in detail above, the properties of fluidic transport coefficient and ink affinity are separate and, as explicitly recited in claim 1, can vary independently and do vary inversely in the claimed apparatus, i.e., "said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity." (Claim 1). Clearly then, these properties are not essentially the same thing, as unsuccessfully argued in the final Office Action.

Moreover, it is improper and insufficient for the final Office Action to merely attempt to explain away the concept of ink affinity rather than indicating how or where such subject matter is taught or suggested in the cited prior art. This is both factually incorrect and insufficient legally to support a rejection of claim 1 under § 102.

If, as the final Action would have it, ink affinity is the closely related to, or the same thing as, the fluidic transport coefficient, then it is impossible as recited in claim 1, for "said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity." Thus, the final Office Action could be taken as arguing that Alonso teaches away from the subject matter of claim 1.

In any event, Alonso clearly does not, and has not been shown to, teach or suggest the subject matter of claim 1. Specifically, Alonso clearly fails to teach or suggest the claimed "second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, the rejection based on Alonso of claim 1 and its dependent claims should not be sustained.

Claim 3:

Claim 3 recites "wherein said second member comprises needle felt." According to the final Office Action, this subject matter is taught by Alonso at col. 2, line 67 to col. 3, line 5. (final Office Action, p. 8). However, this portion of Alonso does not teach, suggest or even mention needle felt as a material for use in an ink over-spray containment apparatus as recited in claims 1 and 3.

The final Office Action, apparently recognizing this clear deficiency of the cited reference, next argues the following. "It would have been obvious to a person having ordinary skill in the art at the time the invention was made to include a needle felt material as the material for said first member, since it has been held to be within the general skill of a worker in the art to select a know [sic] material, such as the above mentioned needle felt, on the basis of its suitability for the intended use." (final Office Action, p. 8).

However, the Action fails to establish any factual basis for drawing this conclusion. In the first place, there is no evidence of record that needle felt is a material with well-known properties that would make it obvious to one of ordinary skill in the art for use in an apparatus such as that claimed. The Examiner must provide such evidence when wishing to draw the conclusion reached.

More importantly, the final Office Action has not shown that the functionality of the claimed apparatus and its members was known in the prior art. To the contrary, the final Action appears to be effectively arguing that Alonso teaches away from the claimed apparatus, as demonstrated above. Consequently, it cannot reasonably be said under these circumstances that one of skill in the art would have known or understood the intended use of the claimed apparatus and its members, let alone known that needle felt could obviously be used in such an apparatus.

As above, the final Office Action makes a leap in rejecting claim 3 that cannot be supported by the present evidentiary record. The simple fact is that Alonso does not teach or suggest the subject matter of claim 3, i.e., "said second member comprises needle felt."

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, the rejection based on Alonso of claim 3 should not be sustained.

Claim 44:

Claim 44 recites "wherein a platen containing said first and second members is further configured to channel ink from flank portions of said first member to said second member." Appellant notes that the term "platen" has a well-understood meaning in the art and in Appellant's specification. As noted in Appellant's specification, a "platen" is a device that "support[s] the print medium (120) in a print zone (not shown) during a printing operation." (Appellant's specification, paragraph 0022).

When the term "platen" is properly defined, it is clear that Alonso does not teach or suggest the subject matter of claim 44. In this regard, the recent Office Action refers to the support frame (17) of Alonso as a "platen." (Action, p. 4). This is clearly an unreasonable. The support frame (17) of Alonso has nothing to do with supporting print media in a print zone and, therefore, cannot be considered or referred to as a platen. Consequently, any teachings of Alonso relevant to support frame (17) have nothing to do with a platen. Therefore, Alonso does not teach or suggest, nor has the Office Action identified in the prior art, a platen like that claimed "containing said first and second members is further configured to channel ink from flank portions of said first member to said second member."

In response to this argument, the final Office Action attempts to take away the Appellant's right to define claim terms in the specification. According to the Action,

> Although "platen" has been defined as a device that support[s] the print medium (120) in a print zone (not shown) during a printing operation (see Applicants' argument in page 16 of the Remarks), please be advised that the features in the specification to which Applicants refer are not recited in the rejected claim, claim 44. although the claim (claim 44) is interpreted in light of the specification, limitation (the platen is used to support the print medium) from the specification is not read into the claim, claim 44, see In re Van Geuns, 988 F.2d 1181,26 USPQ2d 1057 (Fed. Cir. 1993).

(final Office Action, pp. 8-9).

This is directly contrary to the well-established law in this area. Reading directly from the MPEP: "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01." (MPEP § 2173.01) *(see also, Markman v. Westview Instruments*, 116 S. Ct. 1384 (1996); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984); *ZMI Corp. v. Cardiac Resuscitator Corp.*

884 F.2d 1576, 1580, 6 U.S.P.Q.2d 1557, 1560-61 (Fed. Cir. 1988) ("words must be used in the same way in both the claims and the specification.")).

While limitations from the specification are not read into the claims for purposes of patent examination, the definitions of terms used in the claims that are explicitly given in the specification must be respected during examination and claims must be construed accordingly. Thus, as noted above, when the term "platen" is properly defined, it is clear that Alonso does not teach or suggest the subject matter of claim 44.

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Alonso of claim 44 should not be sustained.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of July 2, 2008 is respectfully requested.

Respectfully submitted,

DATE: October 28, 2008

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VIII. CLAIMS APPENDIX

1. (previously presented) An ink over-spray containment apparatus, comprising:

a first member having a first fluidic transport coefficient and a first ink affinity;

a second member coupled to said first member, said second member having a second fluidic transport coefficient lesser than said first fluidic transport coefficient and a second ink affinity greater than said first ink affinity;

wherein said first member comprises porous plastic.

2. (cancelled)

3. (previously presented) The apparatus of claim 1, wherein said second member comprises needle felt.

4-41. (allowed)

42. (cancelled)

43. (allowed)

44. (previously presented) The apparatus of claim 1, wherein a platen containing said first and second members is further configured to channel ink from flank portions of said first member to said second member.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None